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STEVENS & SHOWALTER, L.L.P.

Attorneys at Law

RICHARD C. STEVENS
ROBERT L. SHOWALTER
THOMAS E. LEES

7019 CORPORATE WAY
DAYTON, OHIO 45459-4238

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OF COUNSEL

MICHAEL D. FOLKERTS
CHARLENE L. H. STUKENBORG

* ALSO ADMITTED IN KENTUCKY

TELEPHONE (937) 438-6848
FACSIMILE (937) 438-2124
EMAIL: SSLLP@SPEAKEASY.NET

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REMARKS:

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PETITION TO THE DIRECTOR OF THE USPTO FROM REFUSAL OF THE
PRIMARY EXAMINER TO ENTER AN AMENDMENT AFTER FINAL
REJECTION AND AFTER THE FILING OF A NOTICE OF APPEAL

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ims et al.
Serial No. : 09/754,891
Filed : January 5, 2001
Title : TECHNIQUE FOR AUTOMATED E-BUSINESS SERVICES
Attorney Docket : RSW920000077US1 (IBM010PA)
Examiner : Michael K. Botts
Art Unit : 2176

Commissioner for Patents
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Reg. No. 33,579

**PETITION TO THE DIRECTOR OF THE USPTO FROM REFUSAL OF THE
PRIMARY EXAMINER TO ENTER AN AMENDMENT AFTER FINAL REJECTION
AND AFTER THE FILING OF A NOTICE OF APPEAL**

No fees are believed to be required for this Petition. If, however, a fee is required, the Commissioner is authorized to charge this fee to Deposit Account 090461.

This Petition is being filed pursuant to 37 CFR 1.181 and in response to an Advisory Action dated November 21, 2006, wherein Supervisory Patent Examiner Heather R. Herndon indicated that an Amendment After Final Rejection and After the Filing of a Notice of Appeal (hereinafter "Amendment After Final") would not be entered in the subject application. The Director of the USPTO is respectfully requested to enter the Amendment After Final.

In the Amendment After Final, claims 3, 10 and 17 are deleted and claims 1, 8 and 15 are amended to recite, respectively, the limitations of canceled claims 3, 10, 17. Limitations similar to those added to claims 1, 8 and 15 are added to independent claim 22. Further, the language "configured for" is removed from claims 1, 2, 6 and 7.

The Advisory Action dated November 21, 2006 states in part:

The Examiner notes that the proposed amendments change the scope of the claims, thereby requiring further search and consideration. For example, the amendments incorporate most of the limitations of dependent claim 3 into independent claim 1, thereby adding those

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limitations of [sic: to] the other claims that are dependent from claim 1.

It is noted that § 1206 of the MPEP states:

Amendments filed on or after the date of filing a brief pursuant to 37 CFR 41.37 may be admitted only to:

(B) rewrite dependent claims into independent form.

Rewriting dependent claims into independent form as permitted under 37 CFR 41.33(a)(2) includes the following situations:

(B) rewriting an independent claim to incorporate therein all the subject matter of a dependent claim, canceling the dependent claim and in conjunction therewith changing the dependency of claims which had depended from the dependent claim being canceled to the amended independent claim that incorporates therein all the subject matter of the now canceled dependent claim.

As is apparent from the above section of the MPEP, an applicant is permitted to cancel a dependent claim and incorporate its limitations into an independent claim in an amendment filed after the filing of an Appeal Brief. Hence, it is respectfully submitted that an applicant should be permitted to cancel a dependent claim and incorporate its limitations into an independent claim prior to the filing of an appeal brief.

The Advisory Action dated November 21, 2006 further states:

In addition, all of the original limitations of claim 3 were not incorporated into claim 1, thereby changing the scope of claim 5 which depended from claim 3. Specifically, original claim 3 specified that all of the input documents be encoded in a structured markup language, whereas in the amendment, amended claim 1 now requires less restrictively that "at least one" input document be encoded in a structured markup language.

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Claim 3, as originally filed, recites:

The computer program product according to Claim 1, wherein the specification and the input documents are encoded in a structured markup language.

Amended claim 1 in the Amendment After Final recites:

1. (Currently amended) A computer program product for automated e-business services, the computer program product embodied on one or more computer-readable media of a first computing system and comprising:

computer-readable program code ~~configured for reading to read~~ a specification of an e-business service, wherein the specification is encoded in a structured markup language; and

computer-readable program code ~~configured for processing to process~~ the specification to carry out the e-business service, further comprising:

computer-readable program code ~~configured for receiving to receive~~ at least one input document for the e-business service, wherein the at least one input document is encoded in the structured markup language; and

computer-readable program code ~~configured for performing to perform~~ at least one of: transforming the input documents into other documents, according to transformation information that may be provided in the specification, and operating upon the input documents or the other documents to create one or more new documents, according to operating actions that may be provided in the specification.

It is respectfully submitted that the change in scope between the limitations in claim 3 and the similar limitations incorporated into claim 1 is minor and not sufficient to raise a new issue requiring further search and consideration.

It is also noted that MPEP § 1206 further states:

Amendments filed after the filing of a notice of appeal, but prior to the date of filing a brief, may be admitted only to:

(A) cancel claims;

(B) comply with any requirement of form expressly set forth in a previous action;

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(C) present rejected claims in better form for consideration on appeal;

The Amendment After Final cancels claims 3, 10 and 17. Further, that paper reduces the issues for consideration on appeal due to the cancellation of claims 3, 10 and 17 and, hence, presents the rejected claims in better form for consideration on appeal.

For these reasons, entry of the Amendment After Final is respectfully requested.

Respectfully submitted,
Stevens & Showalter, L.L.P.

By 
Robert L. Showalter
Registration No. 33,579

7019 Corporate Way
Dayton, OH 45459-4238
Telephone: 937-438-6848
Fax: 937-438-2124
Email: rshowalter@sspatlaw.com